



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,983	06/24/2005	Dieter Klatt	SWR-0151	1944
23413	7590	03/03/2006	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

51

Office Action Summary	Application No. 10/517,983	Applicant(s) KLATT, DIETER	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/13/04 (Preliminary Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/04, 3/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers
5 have been placed of record in the file.

Drawings

2. The drawings are objected to because some items in the drawing are written in German,
which should be English (see figures 1-4).

10 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to
the Office action to avoid abandonment of the application. Any amended replacement drawing
sheet should include all of the figures appearing on the immediate prior version of the sheet,
even if only one figure is being amended. The figure or figure number of an amended drawing
should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure
15 must be removed from the replacement sheet, and where necessary, the remaining figures must
be renumbered and appropriate changes made to the brief description of the several views of the
drawings for consistency. Additional replacement sheets may be necessary to show the
renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an
application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"
20 pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will
be notified and informed of any required corrective action in the next Office action. The
objection to the drawings will not be held in abeyance.

Preliminary Amendment

3. Receipt is acknowledged of the preliminary amendment filed on December 14, 2004. In the amendment claims 1-12 were amended, and claims 13-17 were newly added. Currently, claims 1-17 remain in the examination.

5

Obviousness-Type Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

10 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

15 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20

5. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of US Patent 6,443,361 to Klatt et al. (hereinafter '361 patent)

Although the conflicting claims are not identical, it is the Examiner's view that they are not patentably distinct from each other.

25

Claim 1 of the instant application recites "Contacting unit for a card-shaped carrier element for electronic component, including a plug-in card-type housing comprising: a base plate and a cover late congruent in transverse direction; a slot-type plug-in port between the base plate and the cover plate,"

Claim 1 of 361 patent recites “In a contact unit for a card-shaped carrier element of electronic components and including an insertable card-shaped housing that has a base plate and a cover plate that is congruent thereto at least in the transverse direction and between which is formed a slot-like insertion channel that opens on one end of said housing for receiving a chip-
5 card, wherein an opposite end of said housing is provided with a plug-in strip, and wherein a printed circuit board is disposed in said housing parallel to said insertion channel and is electrically connected to said plug-in strip and is furthermore provided on its surface with a contact field for contact with said chip-card, the improvement wherein: exclusively said base plate, at said one end thereof, is provided with an extension in the form of a flat, extending
10 segment that is joined to said base plate via a breaking line to form a first, convertible contact unit, wherein a second contact unit is formed when said segment is detached at said breaking line, and wherein said second contact unit is shorter than said first, convertible contact unit.

Claim 1 of 361 patent is more narrower in scope and recites an extension which is referred in claims 2 and 9-13 of the instant application.

15 Claim 2 of 361 patent recites U-Shaped configuration, including lateral guides.

Other subject matter recited in dependent claims of the instant application (i.e., printed circuit board, a plug-in-strip) are also disclosed in dependent claims of 361 patent, or certainly considered obvious improvement or variations thereof.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
20 overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

5 A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bates
10 et al. (US 6,315,205, hereinafter “Bates”).

Re claim 1, 15-17 Bates discloses a contacting unit (see abstract; see figures 1 and 2) for a card-shaped carrier element for electronic components (col. 2, lines 49+; col. 3, lines 8+), which is a plug-in type housing comprising a base plate 62 and a cover plate 60, which creates an opening for the smart card to be inserted; a printed circuit board 64 which is parallel to the base
15 and cover plates, and electrically connected to the one of the connector 68; and the base plate and cover plate extends in an area that lies in front of an opening (see figure 1). The card can be both PCMCIA type or ISO-7816 standard (col. 1, lines 4+).

Re claims 2 and 3, the width of the handle portion 204 is equal to the width of the base plate 140 (see figures 1 and 2). The slot 20 created by the handle portion 204 serves as a means
20 of inserting or releasing the card.

Re claim 4, the card adaptor body is made up of a plastic material (col. 4, lines 48+).

Re claims 5, 6, and 14, the recess 56 is U-shaped so that the card be a person can grasp inserted card (see figure 1; col. 3, lines 4+).

Re claims 7 and 8, the connector strip 68 is for a PCMCIA card types (col. 2, lines 62+).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 9. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (US 6,315,205, hereinafter "Bates") in view of Takemura (US 5,739,515, hereinafter "Takemura").

The teachings of Bates have been discussed above.

15 Bates fails to specifically teach or fairly suggest that the projection portion is connected to the base plate.

Takemura teaches an IC card reader (see abstract and the main figure) wherein the base plate extends beyond the top portion of the housing. The line that the housing (top portion) and the extended portion meets is a predetermined breaking line.

20 It is the Examiner's opinion that such distinction – existence of the extending base plate – can certainly be considered a design variation element in the card adaptor/reader apparatus. The extended base plate can make inserting of the card or the withdrawing of the card easier without dropping the card. However, U-shaped opening shown in Bates serves the same purpose. Accordingly, it is Examiner's view that one ordinary skill in the art would choose a particular design he/she prefers.

Art Unit: 2876

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Neifer (US 6,520,417 B1); Klatt et al. (US 5,877,438); Hsieh et al. (US 6,761,313 B2); Klatt (US 6,592,031); Knights (US 5,752,857); Stahl (US 6,460,772); Ungermann et al. (US 6,053,775) disclose smart card reader or smart card contacting units. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Ahshik Kim
Primary Examiner
Art Unit 2876
February 21, 2006